

REMARKS

The paragraph of the specification beginning on line 15 of Page 4 (the first paragraph of the Summary of the Invention) and the paragraph of the specification beginning on line 14 of Page 10 have been amended to correct several typographical errors.

Applicant's invention provides an organizer particularly directed to scrapbookers and solving a problem peculiar to the scrapbooking industry. Most paper in use today is rectangular in size and configuration, and not square. Thus, the standard paper size in the United States is eight and one half inches by eleven inches. In some instances, legal size paper, eight and one half inches by fourteen inches is used. Most binders, folders, and paper holders are designed for the usual rectangular shaped pieces of paper. In addition, such binders, folders, and paper holders are usually sized to fit paper of the commonly used dimensions. However, it has become a practice for many scrapbookers to use 12" X 12" square paper. Thus, not only does an organizer pocket for such paper have to be large enough to hold such paper, it is beneficial for such organizer pocket to have a substantially square configuration rather than the usual rectangular configuration. The 12" X 12" paper used by scrapbookers is a specialty paper which is very expensive, costing up to \$3.00 or more a sheet. It is thus very important to protect this paper from damage. It has been found that if the organizer is too large in width so that the paper can slide back and forth in the organizer, the paper can easily be damaged. If the organizer is too large in height, it is more difficult and awkward to put the paper into the organizer without damage to the paper. Further, the excessive material used in making a pocket larger than necessary is expensive and not cost effective, particularly when archival safe materials are used. Therefore, a substantially square configuration for the pockets holding the paper is desirable rather than the usual rectangular pockets of prior art binders, folders, and paper holders.

However, those skilled in the art are used to providing rectangular pockets rather than square pockets so if enlarging a pocket for a larger sheet of paper, would merely enlarge the rectangular pocket to provide a larger rectangular pocket, not a square pocket. To hold 12" X 12" paper, a 13" X 13" pocket has been found to securely hold the paper without damage and allow easy access so that a user can easily insert or remove such paper from the organizer without damage.

Claim 1 of the application has now been amended to recite that the first pockets are substantially square and have dimensions larger than 12" X 12", and Claim 20 has been amended to recite that the at least one of said pockets is substantially square and has dimensions larger than 12" X 12". The drawings show the substantially square configuration of the pockets, and the disclosure on page 12 indicating that "A 13" X 13" pocket provides one preferred size for scrapbook paper organization" specifically describes a substantially square pocket.

The Examiner has rejected Claims 1-5 under 35 USC 103(a) as being unpatentable over Moor et al. Moor et al. show a combination of a binder, such as a three ring binder, for binding sheets of loose leaf paper and a pocket for holding sheets of paper and other items. Moor et al. specifically refer to the binder holding punched loose leaf paper and the pocket holding loose leaf paper, both punched and unpunched. The Examiner acknowledges that Moor et al. do not disclose pockets configured to hold 12 inch by 12 inch sheets of paper.

Applicant's Claim 1 specifically recites that applicant's pockets are "configured for holding and protecting 12" X 12" sheets in an unfolded condition". This is not suggested by Moor et al. The fact that Moor et al. is a combination of a binder and a pocket would lead one to make the pocket in Moor et al. of a size to hold paper usable in the binder or of a size similar to that usable in the binder. Although Moor et al. say that the pocket is "to receive additional papers or to receive papers without holes," and that the pocket "can be used to receive punched

or unpunched paper, as well as other loose items”, nothing in Moor et al. suggests making the pocket to hold larger sheets than would be used in the binder. While twelve inch by twelve inch sheets are intended to be placed in a scrapbook, twelve inch by twelve inch sheets as used in scrapbooking do not fit into binders as disclosed by Moor et al. Moor et al. teach the combination of a binder and a pocket. There is no suggestion in Moor et al. to eliminate the binder and form merely a pocket and there is no suggestion to size the pocket in Moor et al. to hold larger pages than the size of page used in the binder. There would be no purpose in Applicant’s organizer to include a binder with the pockets. A binder would be of no use in applicant’s organizer.

Moor et al. do not make applicant’s organizer without an integral binder obvious nor do they make applicant’s organizer specifically sized for use with twelve inch by twelve inch sheets, larger than used in a binder as described by Moor et al., obvious.

The Examiner argues that it is merely a matter of design choice to construct the pockets to hold a desired size paper and that mere changes in size are within the level of ordinary skill in the art. Therefore, the Examiner argues, “it would have been obvious to modify Moor et al’s organizer to a size, which can accommodate a variety of unfolded sheet sizes”. However, as indicated above, since Moor et al’s invention involves the combination of a binder, such as a three ring binder, and a pocket, it would not be obvious from Moor et al. to eliminate the binder and then enlarge the pocket to a size of paper larger than used in the binder to obtain applicant’s organizer. Moor et al’s binder is an important part of Moor et al’s invention.

Even if a person skilled in the art could “modify Moor et al’s organizer to a size which can accommodate a variety of unfolded sheet sizes”, such modification would not produce Applicant’s pocket. Claim 1, as now amended, also recites that the pockets for holding the 12”

X 12” paper be substantially square. Prior art binders, folders, and paper holders are designed for the usual rectangular shaped pieces of paper. The mere changes in size that would be within the level of ordinary skill in the art referred to by the Examiner, would be changes in size directed to the usual rectangular pieces of paper. It is submitted that those skilled in the art, if merely making a larger version of a prior art binder, folder, or paper holder, such as Moor et al’s combination binder and pocket, would naturally make the larger pocket rectangular in shape. It would not be obvious to change the shape of the pocket to a square pocket. Modifying Moor et al’s organizer to a size to accommodate 12” X 12” paper would provide a rectangular pocket with the shorter side of the rectangle larger than twelve inches and the longer side substantially larger than twelve inches. This would not provide the substantially square pocket required by Claim 1. Moor et al’s pocket would not obviously be transformed into a substantially square pocket.

The Examiner further argues that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.” The Examiner then says, “Therefore, Moor et al’s organizer is capable of holding 12 X 12 sheets in an unfolded condition.” Applicant does not understand this conclusion. First, applicant is not aware of loose leaf paper as large as 12 X 12. Moor et al’s pockets for holding loose leaf paper are not as large as 12 X 12. Therefore, Moor et al’s pockets are not capable of holding 12 X 12 sheets in an unfolded condition. Applicant’s requirement in Claim 1 that the pockets are “configured for holding and protecting 12” X 12” sheets in an unfolded condition” results in a structural difference between the claimed organizer and Moor et al. The requirement in the claim requires

that the pockets of the organizer of the invention be of a size structurally large enough to hold the 12" X 12" sheets where the Moor et al. device is not structurally large enough to hold such sheets in unfolded condition. Further, since the size of the larger pockets needed to hold 12" X 12" sheets would not correspond to a similar binder size, Moor et al's device would have to be further structurally changed to hold a small binder and large sheets. This is not be an obvious change. If the Examiner bases this rejection on a lack of structural recitation in Claim 1 reciting the size of the pockets, applicant has now amended Claim 1 to clearly recite the structural limitation that the pocket has "dimensions larger than 12" X 12"". This clearly provides a structural limitation and is not merely "a recitation of the intended use". Claim 20 has been amended similarly to Claim 1.

The Examiner rejects Claims 1-6, 20 and 21 under 35 USC 103(a) as unpatentable over Hatano et al. in view of Hatano et al's prior art. Hatano et al. teach what they refer to as a "folder". The Hatano et al. folder is a plastic box with a plurality of interconnected envelopes therein, the envelopes being arranged so that when the tab on the envelope at the back of the box is pulled upwardly from the box, it will pull with it the other envelopes in front of it in series as shown in Hatano et al's Fig. 5 to show the front of all of the envelopes. The envelopes are disclosed as all being interconnected, with the first envelope connected to the bottom of the box. Therefore, the envelopes do not appear to be removable from the box. The box includes a stand so that it will stand on a surface, such as a table, as the envelopes are pulled upwardly in the box to supposedly display the contents. The box is not disclosed as or shown as expandable, nor is it disclosed as transparent. The side walls 12 and bottom 13 appear from the drawings to be rigid and are disclosed merely as side walls and a bottom.

The Examiner refers to the prior art cited in Hatano et al. as disclosing transparent folders made of plastic. Hatano et al. disclose as prior art plastic folders with transparent fronts. Hatano et al. refer to the prior art as “a folder is made of plastic material and has a rear plate and a front plate which is usually made of transparent material and is connected to the rear plate . . .” Thus the front plate is described as made of transparent plastic, not the rear plate. This is further supported several lines down in the description of the prior art where Hatano et al. say that when the prior art folders are placed one by one to form a row in a drawer, to find a document, each folder has to be pulled out of the drawer “although the front plate of the folder is transparent.” Hatano et al. continue describing the prior art by saying “If documents or drawings received in the folders are to be displayed in front of customers, the displayer will need a proper display device to show them conveniently on the table.” Thus, the purpose of the Hatano et al. invention appears to be to provide a folder which allows easy display of the contents of the envelopes. This is presumably done by providing the pull out envelopes which, when pulled out as shown in Fig. 5, easily display the contents of the envelope through the transparent front of the envelope.

In rejecting the claims under Hatano et al., the Examiner says “Hatano et al discloses in Fig. 1-3, an expandable transparent organizer”. Applicant does not agree. As pointed out above, Hatano et al. do not show an expandable organizer. Figs. 1-3 show rigid walls and nothing in Hatano et al. indicate that the folder is expandable. The folder body 10 appears to be a rigid, open top plastic box. Hatano et al. do not show a transparent organizer. Nothing in Hatano et al. indicate that any of the box body 10 is transparent. It would follow from the description of the prior art folders with transparent fronts, and from the indication that documents in the folders should be displayed when the envelopes are pulled out as shown in Fig. 5, that the front of the envelopes 30 would be transparent. However, nothing else in Hatano et al. is indicated as

transparent. The documents in the envelopes are identified by an index in the portion 33 extending from the top of each envelope. Thus, nothing apart from the front of the envelope is suggested as transparent. Hatano et al. do not show an expandable organizer for organizing and holding paper as taught and claimed by applicant, but teach a display device which can be stood on a surface such as a table (the reason for the stand) where documents are arranged in envelopes so that they can be accessed and easily displayed to customers. It does not appear that sheets are easily placed into or removed from the envelopes. The Hatano et al. folder is not used and would not be used for storage of paper to be used for other purposes such as scrapbooking.

The Examiner argues that “In regard to Claim 1, it would have been an obvious matter of design choice to construct the pockets to hold any desirable sized sheets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to modify Hatano et al.’s organizer to a size that can accommodate a variety of unfolded sheet sizes, since such a change would not alter the function of the pocket for holding sheets of paper, and it would be based upon the item the end user would want to place in the pocket.” While it is possible to change the size of the folder body 10 and the envelopes 30 in Hatano et al. to accommodate desired sizes of sheets, such modification of Hatano et al. would not provide applicant’s organizer. It would not provide a storage device for paper to be taken and used for other purposes. It would not provide an expandable organizer with storage pockets for paper. It would provide a series of interconnected envelopes that can be pulled out in a serial arrangement as shown in Fig. 5. These envelopes would not normally be used for paper storage. Increasing the size of the Hatano et al. device would provide a display device which can be stood on a table for displaying large sheets of information to customers. Substantial changes would

have to be made to the Hatano et al. device to convert it from a large display device to applicant's claimed organizer for storing sheets of paper. There is nothing in Hatano et al. or the Hatano et al. prior art to suggest that such necessary changes be made, and such changes, if made, would defeat the whole purpose of the Hatano et al. device. The changes necessary to convert the Hatano et al. device to applicant's device would alter the function of the Hatano et al. device.

In addition, as argued above for the pockets in the Moor et al. device, since Hatano et al. show rectangular envelopes, any mere enlargement of the envelopes would provide rectangular rather than substantially square envelopes. This would not give applicant's device. Nothing in Hatano et al. would suggest changing Hatano et al.'s usual rectangular envelopes to substantially square envelopes.

Neither the modification of the Moor et al. device or the Hanato et al. device suggested by the Examiner would be an obvious modification. Modifying the Moor et al. device to applicant's device would require eliminating an important element of the Moor et al. device, the binder, along with increasing the size of the Moor et al. device and changing the shape of the Moor et al. device. This would prevent those skilled in the art from making the suggested modifications to Moor et al. Applicant's organizer is not obvious from Moor et al. Modifying the Hatano et al. device to applicant's device would require eliminating the important display feature of the device, i.e., the arrangement of the pockets of the Hatano et al. device, and thereby change the whole function and construction of the Hatano et al. device. This requirement would prevent those skilled in the art from making the suggested modifications to Hanato et al. Applicant's organizer is not obvious from Hatano et al.

With regard to Claim 6, Hatano et al. do not describe or even mention the second pocket referred to by the Examiner as visible in Fig. 1 of Hatano et al. Thus, we do not know if this is really a pocket. The Examiner says that Hatano et al. show “a second pocket (seen in Fig. 1), which can be seen when the organizer is in a closed position (since cover walls (15) are transparent).” However, none of the Figs. show the cover closed over the alleged pocket with the pocket visible through the cover, and, as pointed out above, there is nothing to indicate that cover wall 15 is transparent. The only walls indicated by Hatano et al. and by the Hatano et al. prior art as being transparent are the fronts of the envelopes 30, not the cover wall 15. Claim 6 should be allowable.

The Examiner rejects Claims 7-18 under 35 USC 103 as being unpatentable over Hanato et al. in view of Hatano et al.’s prior art and further in view of Lee et al. The Examiner says that Hatano et al as modified by Hatano et al.’s prior art “discloses an organizer comprising all the elements as claimed in Claim 1”. The Examiner then says that “Hatano et al further discloses that the second pocket (seen in Fig. 1) that can be seen when the organizer is in closed position (since cover walls are transparent).” The Examiner then adds the reference to Lee as showing in Figs. 1 and 2 of Lee, “a second pocket for holding a data storage medium (28) and a third pocket for holding a computer disk, wherein the walls (cover) of the pockets are see through.”

With respect to Claims 7-10, which depend from Claim 1, as argued above, Claim 1 as currently amended is not made obvious by Hatano et al. in view of the Hanato et al. prior art. Therefore, Claims 7-10 should be allowable. Further, with regard to Claims 7-9, which depend from Claim 6, as argued above, Hatano et al. do not describe or even mention the second pocket referred to by the Examiner as visible in Fig. 1 of Hatano et al. Thus, we do not know if this is really a pocket. Further, as pointed out above, there is nothing to indicate that cover wall 15 is

transparent. The only walls indicated by Hatano et al. and by the Hatano et al. prior art as being transparent are the fronts of the envelopes 30, not the cover wall 15. Claims 7-10 should be allowable.

With regard to Claims 8 and 11, applicant does not agree with the Examiner that Lee et al. show the “third pocket for holding a computer disk”. Applicant has not found what the Examiner refers to as the third pocket for holding a computer disk. Pocket 26 in Lee is for holding computer media, pocket 28 is a label holder and folds when the folder of Lee is in closed condition. Label holder 28 is not a pocket for holding a computer disk and does not comprise a “third pocket for holding a computer disk”. While Lee et al. say that “In a preferred embodiment, the holder 26 is dimensioned to receive two or more 3.5” floppy diskettes in side-by-side or overlying relationship”, this is still one pocket, not two pockets of different dimensions. In Lee et al. pocket 26 is a pocket to hold a data storage medium. Pocket 28 referred to by the Examiner is a label holder “extending from the front flap 14a to the back 14c across the top 14b. When in the closed configuration depicted in Fig. 1, the label holder should be taught.” The label holder 28 is preferably “arranged so as to define an envelope for a sheet of paper having the dimensions equaling one half of a sheet of letter sized paper. Advantageously, a standard sheet of letter sized paper may be folded into half, . . . and then inserted into the holder. This approach dispenses with the need for special labels . . .” Further, Lee et al. say “The preferred embodiment also provides a label holder 8 ¼” wide by 5 ½” tall, which after attachment at the margins thereof to the cover along the two lateral sides provides an open-topped and open-bottomed interior envelope accommodating a half sheet of letter-sized paper, viz. 8 ½” by 5 ½”.” This is clearly not disclosed as a pocket to hold a data storage medium. Thus, label holder 28 is not a third pocket as contemplated by applicant’s claims.

Further, with respect to Claim 11, Claim 11 has been amended to recite that the third pocket is “for holding an item to be used during scrapbooking, and positioned entirely on one of the front or rear walls”. The second pocket is also defined as “for holding an item to be used during scrapbooking, and positioned entirely on one of the front or rear walls”. The items used for scrapbooking held in the second and third pockets may be data storage medium, if desired. Lee et al. do not show or suggest two pockets of different sizes each positioned entirely on one of the front or rear walls of the organizer. The label holder of Lee et al. is attached to both the rear wall and front flap and extends across the top of the Lee et al. organizer so is not positioned entirely on either the front or rear wall, as now required by Claim 11. The positioning of Lee et al.’s label holder would not make applicant’s two pockets obvious. Further, Lee et al.’s label holder is not a pocket for holding scrapbooking items, particularly if it has both an open top and open bottom. In addition, Lee et al. specify that their preferred embodiment “is dimensioned to be about 13” wide, 9 3/8” tall and 1 1/8” deep.” This clearly is not “configured for holding and protecting 12” X 12” paper in an unfolded condition” as also required by Claim 11. Lee et al.’s device is dimensioned to hold the normal rectangular paper. Thus, it adds nothing to either Moor et al. or Hanato et al. to suggest sizing an organizer for the unusual square paper.

Claim 11, and Claims 12-19 dependent thereon, should be allowable.

Claim 15 has been amended to recite that the third pocket is positioned on the rear wall inside the first expanding pocket. This positioning for a pocket is not shown or suggested by the cited prior art. Claim 15 should be allowable.

While applicant does not believe that her organizer is obvious from the cited Moor et al. and Hatano et al. references as explained above, if the Examiner believes that the question of obviousness remains close, applicant again points to the Declarations submitted with the

response dated October 8, 2004. The Examiner has not given any weight to the declarations on the ground that the Declarations refer only to the system described in the application and do not refer to the individual claims. However, the declarants do refer to the features required by the claims, specifically that the system of the invention holds and protects twelve inch by twelve inch paper, and indicate that the holding and protecting of the twelve inch by twelve inch paper is the feature of applicant's system that resulted in the commercial success of the system and resulted in the extensive copying of applicant's system. The declarations do address a specific feature of the claims that resulted in commercial success of applicant's organizer. All of applicant's claims require that the plurality of first expanding pockets be configured for holding and protecting 12" X 12" sheets in an unfolded condition. The commercial success of the invention is in the field of scrapbooking. Therefore, the declarants' knowledge and expertise in the scrapbooking industry is important. Knowledge and expertise in the many structures of organizers apart from the scrapbooking industry is not important here since applicant's organizer, and the competitive organizers, enjoy commercial success in the scrapbooking field, not the organizer field apart from the scrapbooking industry, and the long felt but unfilled need was in the scrapbooking industry, not the organizer field apart from the scrapbooking industry. The declarations are sufficient to show secondary factors of nonobviousness.

Please charge any additional fees due, or deposit any overpayments, to Deposit Account
No. 20-0100 of the undersigned.

Dated this 22nd day of September, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert R. Mallinckrodt", written in a cursive style.

Robert R. Mallinckrodt
Attorney for Applicant
Registration No. 26,565

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone: (801) 566-6633

RRM/rrm